

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

META PLATFORMS, INC.
Petitioner

v.

MOBILE DATA TECHNOLOGIES, INC.,
Patent Owner

Case IPR2024-00248
U.S. Patent No. 9,032,039 B2

PETITIONER'S PRELIMINARY REPLY

Petitioner respectfully submits this Preliminary Reply, as authorized by the Board, to address certain issues raised by Patent Owner (“PO”) under § 325(d).

Neibauer, Cheng and Squibbs: Under Part Two, “if ‘the record is not well developed or silent,’” the Petitioner “must simply ‘show [that] the Office [materially] erred by overlooking something.’” *LG Elecs. v. Pantech*, IPR2023-01273, Paper 26 at 15 (PTAB April 9, 2024) (quoting *Advanced Bionics*). The record on *Neibauer, Cheng and Squibbs* is entirely “silent” because the Examiner never addressed them. Petitioner cannot read the Examiner’s mind, so any assertions about what he may have thought about those references would be pure speculation.

As the Petition explained, the Examiner erred by overlooking these references and the compelling grounds of unpatentability they provided. (Petition, 5-6.) Petitioner has filed IPRs against several patents in this family, and this one of the few instances in which a prior art rejection was actually entered (based on Gobburu). Petitioner thus explained that *Neibauer, Cheng, and Squibbs* were stronger prior art because they disclosed the limitations the Examiner thought were missing from Gobburu and Calder (which the Examiner cited in combination with Gobburu). (*Id.*) The Petition further explained that the claimed recitation of a previously established application-based information channel and inserting content into that channel – a key amendment the applicants made to overcome Gobburu – was disclosed by *Neibauer* including its photo sharing feature. (*Id.*, 6.) As further evidence of error,

the Petition noted that U.S. Patent No. 8,135,801, a great grandparent whose claims were invalidated in reexamination based on Neibauer and Cheng. (*Id.*, 6.) The use of Neibauer and Cheng to invalidate claims in the '801 reexamination should have alerted the Examiner to their relevance to the claims of the pending '039 claims.

PO asserts that Petitioner did not adequately show the existence of material error under § 325(d), but does not explain what else Petitioner could have said on this topic given the prosecution history. *Advanced Bionics* makes clear that if the record with respect to a reference is “silent,” as it was here, the Petitioner “must simply ‘show [that] the Office [materially] erred by overlooking something.’” *LG Elecs.*, *supra*, at 15. The Petition did this, and more, by explaining the Examiner’s error in overlooking Neibauer, Cheng, and Squibbs, which disclosed the very limitations the Examiner relied upon in allowing the claims over Gobburu.

Bandera: PO acknowledges that Bandera was not considered but argues that it is substantially similar to Dowling. (POPR, 12-13.) PO offers nothing more than block quotes from Dowling without any meaningful analysis, and has made no showing of substantial similarity. PO cites Exhibit 2003, but this is not Dowling but an unrelated reference. Petitioner has attached a copy of Dowling as Exhibit 1030.

The Petition cited Bandera for its disclosure of selecting and delivering advertisements based on the physical location of the user’s device, ***and*** its ability to display these advertisements alongside other content on the page. (Petition, 49-53.)

The Petitioner further explained how Bandera was combinable with Neibauer given their similar disclosures of advertisements being displayed on the *same web page* with other (non-advertising) content. (*Id.*, 50-53.)

Dowling merely discloses the ability to provide location-based promotional information via a web page. (POPR, 12-13.) Dowling does not state that the promotional information is presented on the same page alongside other (non-advertising) content. It appears to disclose the opposite, by stating that when a user drives along a mall, “*a web page comes up and provides directions to the shopping mall.... [and] directions to the desired store.*” (POPR, 13 (quoting Dowling, ¶0064).) The ability to bring up a *different web page* is materially different from Bandera's disclosure of advertising content on the *same web page* as other content. This distinction is significant because the “**additional content**” of claim 21 is not displayed by itself – claims 19 and 20 further require that the additional content be integrated with other content items as part of the application-based information channel. (Petition, 42-43, 50-52.) The references are thus materially different.

Harvey: PO's arguments about Harvey are puzzling considering that it insists the Board need not even consider Harvey. (POPR, 12.) PO also does not identify any other reference that is allegedly similar to Harvey. In connection with *other* IPR petitions, PO argued that Harvey was cumulative of Sutherland (which Petitioner addressed), but PO does not renew those arguments here.

Petitioner's Preliminary Reply
IPR2024-00248

Dated: April 22, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify, pursuant to 37 C.F.R. Section 42.6, that a complete copy of the attached **PETITIONER'S PRELIMINARY REPLY** and related documents are being served via electronic mail on the 22nd day of April 2024 upon the Patent Owner's attorneys of record in this proceeding as follows:

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